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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Sklar, et al.
U.S. APPLICATION NO. : 10/771,853
FILING DATE : February 2, 2004
TITLE : Multiplex Analysis for High Throughput Discrimination
of GPCR Agonists and Antagonists
GROUP ART UNIT : 1647
EXAMINER : S.H. Shafer

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Restriction Requirement

In response to the Examiner's office action dated April 3, 2006, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group IV, consisting of claims 42-47, which are drawn to methods for evaluating GPCR agonism, antagonism or inactivity in a sample by flow cytometric process. Notwithstanding the election, Applicants respectfully request the Examiner to give serious consideration to examining the inventions of groups II and IV together, given that Applicants view those claims as integral to each other, even though they relate to patentably distinct methods. In the alternative, Applicants request that the Examiner consider examining all of the claims of groups II-V, namely claims 27-55, all of which are directed to patentably distinguishable, although similar methods, all of which are classified in the same class and subclass, namely class 435, subclass 7.1.

At the request of Applicants and in the interest of an efficient examination of this application, Applicants respectfully request the Examiner to give consideration to examining *all* of the claims of groups II-V, namely claims 27-55 together for purposes of expediting prosecution of the present application. All of the inventions are related, though patentably distinct methods. Moreover, in the case of the inventions of groups II-V, claims 27-55, the inventions are classified in the same class (435) and subclass (7.1).

Notwithstanding Applicants' election, Applicant respectfully traverses the Examiner's requirement for restriction. Applicant respectfully requests the Examiner reconsider his restriction requirement in its entirety. Applicant respectfully submits that prosecution of all of the originally filed claims should not be restricted to the elected invention, for the reasons which are set forth hereinbelow.

According to MPEP § 803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of all of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims of groups II-V are related, though patentably distinct methods having a broad common utility. Indeed, the invention of groups II and IV, claims 27-40, 42-47 and 54 are closely related and are viewed as being integral to each other.

Although the claimed invention groups are generally patentably distinct from each other, Applicant respectfully submits that any search the Examiner would need to conduct in examining the instant application and the examination itself would not be unduly burdensome. Moreover, the examination of all of originally filed claims 27-55 in the instant application would not place such a serious burden on the Examiner as to require restriction. This is especially true for the inventions of groups II and IV, the subject matter of which is classified in class 435, subclass 7.1, as are the other method claims.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention.

Applicants respectfully submit that the originally filed claims 27-55 are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in MPEP § 803- this is especially true considering that all of those claims are classified within the same class (435), and subclass (7.1). Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement and consider examining claims 27-55 or at least the inventions of groups II and IV, given that the subject matter of those claims falls within the same class (435) and subclass (7.1).

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way. No fee is due for the presentation of this response.

If any additional fee is due or any overpayment has been made, please debit or credit Deposit Account 04-0838.

Respectfully submitted,

COLEMAN SUDOL SAPIONE P.C.

By: 

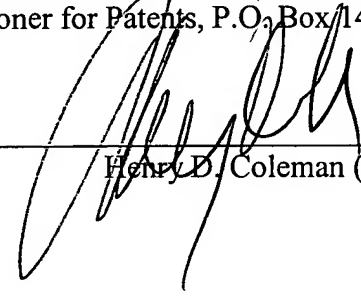
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Dated: May 2, 2006

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on May 2, 2006.


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